

SEP-24-2004 12:02 HEWLETT PACKARD LGL FCOLL  
Intellectual Property Administration  
P. O. Box 272400  
Fort Collins, Colorado 80527-2400

970 898 7247 P.02/59  
**PATENT APPLICATION**

ATTORNEY DOCKET NO. 10970451 -4

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lawrence N. Taucher

Confirmation No.: 7870

Application No.: 08/823823

Examiner: Neyzari, Ali

COPY

Filing Date: Mar 25, 1997

Group Art Unit: 2655

Title: Write Protect For Rewritable Compact Disks And Digital Video Disks

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on 09/24/2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( ) one month	\$110.00
( ) two months	\$420.00
( ) three months	\$950.00
( ) four months	\$1480.00

( ) The extension fee has already been filled in this application.

( ) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

( ) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit: \_\_\_\_\_  
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(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number 17031872-9306 on 09/24/2004

Number of pages: 59

Typed Name: Donna M Kraft

Signature: Donna M Kraft

Respectfully submitted,

Lawrence N. Taucher

By A. L. Winfield

Augustus W Winfield

Attorney/Agent for Applicant(s)  
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Date: 09/24/2004

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PATENT APPLICATION  
ATTORNEY DOCKET NO. 10970451-4

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UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lawrence N. Taucher

Serial No.: 08/823,823

Examiner: Neyzari, Ali

Filing Date: 03/25/97

Group Art Unit: 2655

Title: WRITE PROTECT FOR REWRITABLE COMPACT DISKS AND DIGITAL VIDEO  
DISKS

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Alexandria VA 22313-1450

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BRIEF ON APPEAL

INTRODUCTION

Pursuant to the provisions of 37 CFR § 1.191 *et seq.*, applicants hereby appeal to the Board of Patent Appeals and Interferences (the "Board") from the examiner's final rejection dated 01/02/01. A notice of appeal was timely filed on 09/24/2004 concurrently with this brief on appeal, in accordance with 37 CFR § 1.8. This brief on appeal is being filed in triplicate (37 CFR § 1.192(a)) and is accompanied by the requisite fee (37 CFR 1.192(a) and 1.17(c)).

REAL PARTY IN INTEREST

The entire interest in the present application has been assigned to Hewlett-Packard Company, as recorded at reel 8690, frame 0272.

**RELATED APPEALS AND INTERFERENCES**

An earlier appeal brief was filed on 06/04/2001 (Appeal No. 2002-1235). The Board of Patent Appeals and Interferences, in a decision received 11/18/2003, reversed and remanded in light of a full translation of Japanese Published Unexamined Patent 04-095287 (Takahashi). A copy of the previous decision is attached as Appendix II.

**STATUS OF CLAIMS**

Claims 1-11 are pending in the application.

Claims 1-11 have been finally rejected.

Claims 1-11 are on appeal.

**STATUS OF AMENDMENTS**

There are no after-final amendments.

**SUMMARY OF CLAIMED SUBJECT MATTER**

The invention relates generally to digital mass memory media, and more specifically to rewritable optical disks, and still more specifically to devices and methods used to prevent writing to a rewritable optical disk. One layer of the media is a phase change material (figure 2, 200; page 3, line 25) having a transparency that can be reversibly changed by heating, and then cooling at a controlled rate (page 3, line 26, to page 4, line 3). A laser (figure 1, 104; page 3, line 22) is used to heat, and then cool small areas at a controlled rate. Laser power must be calibrated for each disk medium (page 4, lines 14 - 18). Before writing or erasing, a standard drive must successfully calibrate laser power by writing into a Power Calibration Area (figure 3, 304) on the medium. If the drive cannot read its calibration patterns in the Power Calibration Area, it will not erase or write in the data area of the disk. In some example embodiments of the invention, the Power Calibration Area is temporarily obscured, preventing a successful calibration. For example, the Power Calibration Area may be covered by removable opaque plastic rings (figure 4, 406; page 4, line 24 through page 5, line 13) or adhesive labels (figure 5, 500; page 5, lines 13-23). In other example embodiments, the Power Calibration Area is permanently obscured or covered for permanent write protection. For example, the surface of the disk in the Power Calibration Area may be scratched or abraded (figure 6; page 6, lines 5-12).

Finally, the phase change material in the Power Calibration Area may be intentionally damaged (page 6, lines 13-20), rendering the disk permanently write protected.

Claim 1 specifies an apparatus for write protection of a disk (figures 1 and 3, 102), the disk having a power calibration area (figure 3, 304; page 4, lines 14-19) and a data area (figure 3, circle 302 defines the beginning of the data area; page 4, lines 10-12), the apparatus comprising a ring (figure 4, 406; figure 5, 500) capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Claim 2, dependent on claim 1, further specifies the disk having a central hole (figures 3 and 4, 300) and an indented area (figure 4, 402; page 4, line 24, through page 5, line 6) formed around the hole, the ring adapted for insertion into the indented area.

Claim 3, dependent on claim 1, further specifies that the ring comprises an adhesive label (figure 5, 500; page 5, lines 13-20).

Claim 4, dependent on claim 1, further specifies that the ring is transparent initially, and then darkened by exposure to a laser (page 6, lines 21-28).

Claim 5 (independent) specifies an apparatus for write protection of a disk (figures 1 and 3, 102), the disk having a central hole (figures 3 and 6, 300) and a power calibration area (figure 3, 304; page 4, lines 14-19), the apparatus comprising a holder (figure 6, 600; page 6, lines 5-12) adapted to fit into the central hole of the disk and an abrasive tool (figure 6, 606) rotating around the holder, adapted to abrade the power calibration area when rotated.

Claim 6 (independent) specifies a method of write protection for a disk (figures 1 and 3, 102), the disk having a power calibration area (figure 3, 304; page 4, lines 14-19) for a laser, and a data area (figure 3, circle 302 defines the beginning of the data area; page 4, lines 10-12), the method comprising shielding the power calibration area, but not the data area, of the disk from light sufficiently to prevent a disk drive from using the power calibration area to calibrate a laser (page 4, line 19; page 4, line 28 through page 5, line 2; page 5, lines 17-18 and lines 20-21; page 6, lines 8-9 and lines 24-25).

Claim 7, dependent on claim 6, further specifies that the disk is adapted to receive light from a laser having a particular wavelength (page 5, lines 6-7), the step of shielding further comprising covering the power calibration area with a material that is non-transparent at the particular wavelength (page 5, lines 6-9 and lines 21-23).

Claim 8, dependent on claim 7, further specifies that the material comprises an adhesive label (figure 5, 500; page 5, lines 13-20).

Claim 9, dependent on claim 7, further specifies that the material comprises an ink (page 5, lines 20-21).

Claim 10, dependent on claim 7, further specifies that the material comprises a dye (figure 5, 500; page 5, lines 13-20).

Claim 11, dependent on claim 7, further specifies that the material comprises a paint (figure 5, 500; page 5, lines 13-20).

#### **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 1-11 are unpatentable under 35 U.S.C. § 103(a) in light of prior art disclosed in the specification, in view of "CD Recordable Handbook" by Parker and Starrett, and further in view of Japanese Patent Number 404095287 (Takahashi).

#### **ARGUMENT**

##### **Claims 1-3 and 6-11**

In claims 1-3 and 6-11, the power calibration area, but not the data area, is covered. The cited prior art, individually or in combination, do not teach or suggest covering or shielding the power calibration area, but not the data area.

Applicant stipulates that the power calibration area is known in the prior art (Parker and Starrett). Further, applicant is not contesting the combination of Parker and Starrett with Takahashi for claims 1-3 and 6-11. However, applicant is contesting whether there is any teaching or suggestion to modify the combination to implement the specific limitations of independent claims 1 and 6.

Takahashi discloses covering at least part of the recording area, but does not teach or suggest specifically not covering the data area. The examiner states the general (existence of the power calibration area, and covering at least part of the recording area) and simply concludes the specific limitation of covering just the power calibration area, and

not covering the data area, without reference to any suggestion or motivation in the prior art to modify.

In the office action dated 06/24/2004, regarding modification of the prior art, the examiner merely refers to the office action dated 12/24/2003. In the office action dated 12/24/2003, the examiner states:

“Therefore, it would have been obvious to one of ordinary skill in the art to cover the power calibration area of the disk of the prior art discussed above in the same manner that the recording area of the disk is covered in Takahashi.

Since it was admittedly known in the prior art (discussed above), that the Power Calibration Area (PCA) of the disk is necessary readable in order to effect recording, therefore, it would have been obvious to one of ordinary skill in the art, based upon the admitted prior art and Takahashi, to cover the functional area of the disk other than the recording area, such as “Power Calibration Area”.”

The examiner's statements are an unsupported conclusion, and do not meet the requirements of a *prima facie* case for obviousness. From MPEP 2142, the combined prior art references must teach or suggest all the claim limitations. The prior art references do not teach the specific limitation of covering the power calibration area but not the data area. Accordingly, the references must be modified. In Takahashi, page 5, lower right column, line 5 to line 10, where Takahashi suggests covering at least part of a recording area, it is in the context of a seal member that permits light for reading but prevents light from recording. That is, if the seal does not interfere with reading, then it does not matter whether it covers up part of the data area. Accordingly, there is no motivation within the combination of references to modify the references to require the limitation that the data area is not covered. Applicant respectfully submits that if one covers the power calibration area in the same manner that the recording area of the disk is covered in Takahashi, then there is no motivation to not cover the data area, because in Takahashi reading can still occur if part of the data area is covered.

In response to applicant's argument that teaching of a general arrangement does not teach or suggest a specific arrangement, in the office action dated 06/24/2004, the examiner acknowledged *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Jones*, at page 1942, as discussed in MPEP 2143.01, teaches that disclosure of a

chemical genus does not render obvious any species that happens to fall within it. It is not clear to the applicant whether this cite was an acknowledgement of the validity of the applicant's argument, or was intended to be a rebuttal.

#### Claim 4

Claim 4, dependent on claim 1, specifies a ring that is initially transparent, that is then darkened by exposure to a laser. The examiner has cited no prior art, individually or in combination, teaching or suggesting a transparent ring that is darkened by a laser. Accordingly, no *prima facie* case for obviousness has been established for claim 4.

In the Board's decision in the previous appeal (Appendix 2), at page 6, the Board instructs the examiner to determine the obviousness of each of the appealed claims argued separately by the applicant. The examiner has failed to address the specific limitations of claim 4. In the office action dated 12/24/2003, at page 4, the examiner lumps claim 4 with claims 8-11, citing only seals in Takahashi having dark/bright patterns, and seals of a single color, which are irrelevant to a transparent ring that is darkened by a laser.

#### Claim 5

Claim 5 specifies an apparatus adapted to abrade the power calibration area of a disk. The examiner has cited no prior art, individually or in combination, teaching or suggesting an apparatus for abrading a functional area of a recordable medium.

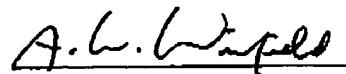
Accordingly, no *prima facie* case for obviousness has been established for claim 5.

Regarding claim 5, in the office action dated 12/24/2003, at page 4, the examiner states that Takahashi teaches that by covering or painting the power calibration area, the phase change material or transparent cover layer is partially damaged or destroyed. First, Takahashi does not teach a power calibration area. Second, Takahashi does not teach that covering or painting damages or destroys the phase change material or the transparent cover layer. Third, Takahashi does not teach or suggest abrasion.

**CONCLUSION**

In view of the above, applicant respectfully requests that the examiner's rejection of claims 1-11 be reversed.

Respectfully submitted,



Augustus W. Winfield

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September 24, 2004  
Fort Collins, CO 80528-9599  
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**APPENDIX 1****CLAIMS ON APPEAL**

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:
  - a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.
2. The apparatus of claim 1, the disk having a central hole and an indented area formed around the hole, the ring adapted for insertion into the indented area.
3. The apparatus of claim 1, the ring comprising an adhesive label.
4. The apparatus of claim 1, the ring being transparent initially, and then darkened by exposure to a laser.
5. An apparatus for write protection of a disk, the disk having a central hole and a power calibration area, the apparatus comprising:
  - a holder adapted to fit into the central hole of the disk; and
  - an abrasive tool, rotating around the holder, adapted to abrade the power calibration area when rotated.
6. A method of write protection for a disk, the disk having a power calibration area for a laser and a data area, the method comprising:
  - shielding the power calibration area of the disk, but not the data area, from light sufficiently to prevent a disk drive from using the power calibration area to calibrate a laser.

7. The method of claim 6, the disk adapted to receive light from a laser having a particular wavelength, the step of shielding further comprising:  
covering the power calibration area with a material that is non-transparent at the particular wavelength.
8. The method of claim 7, the material comprising an adhesive label.
9. The method of claim 7, the material comprising an ink.
10. The method of claim 7, the material comprising a dye.
11. The method of claim 7, the material comprising a paint.

**APPENDIX 2**

**PREVIOUS DECISION BY THE BOARD OF PATENT APPEALS AND  
INTERFERENCES**

**APPENDIX II**

10970451-4

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

NOV 18 2003

HP LEGAL  
IPAEx parte LAWRENCE N. TAUGHERAppeal No. 2002-1235  
Application No. 08/823,823

ON BRIEF

Before KIMLIN, WARREN and WALTZ, Administrative Patent Judges.  
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11.

Claim 1 is illustrative:

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:

a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Appeal No. 2002-1235  
Application No. 08/823,823

In addition to the admitted prior art, the examiner relies upon the following references as evidence of obviousness:

Takahashi et al. (Takahashi) 04-095287 Mar. 27, 1992  
(Japanese Published Unexamined Patent)

Dana J. Parker et al. (Parker), CD-ROM Professional's CD-Recordable Handbook - The Complete Guide to Practical Desktop CD 82-85 (David R. Guenetta ed., 1996)

Appellant's claimed invention is directed to an apparatus and method of providing write protection of a recordable disk by covering or altering the power calibration area of the disk. According to appellant's specification, before writing or recording information on a disk, the disk drive must calibrate laser power by writing into the power calibration area. If the drive cannot read its calibration pattern in the calibration area on the disk, "it will not erase or write in the data area of the disk" (page 2 of specification, second paragraph). In the present case, appellant covers or abrades the power calibration area to prevent writing data on the recordable area of the disk.

Appealed claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph. Appealed claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Parker and Takahashi.

Appeal No. 2002-1235  
Application No. 08/823,823

Appellant presents separate arguments for claims 1, 4, 5, 6 and 7, whereas claims 2, 3 and 8-11 stand or fall together with the claims upon which they depend.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the examiner's rejections are not well-founded. Accordingly, we will not sustain the examiner's § 112 and § 103 rejections.

Concerning the examiner's rejection of claims 1-4 under § 112, second paragraph, it is the examiner's position "the phrase 'capable of' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention" (page 3 of Answer, last sentence).

However, we agree with appellant that the claim language is an appropriate use of functional language which requires that the recited ring be capable of being attached to the disk such that it covers the power calibration area but not the data area. The examiner has not met the initial burden of explaining why, prima facie, one of ordinary skill in the art would not be reasonably apprised of the scope of claims 1-4.

We now turn to the examiner's § 103 rejection of all the appealed claims. The examiner correctly states that it is part

Appeal No. 2002-1235  
Application No. 08/823,823

of the admitted prior art that a recordable disk has a power calibration area that must be read by a laser before recording is accomplished. The examiner then concludes that "[t]o cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art" (page 4 of Answer, third paragraph). The examiner further cites Figure 1 of Takahashi for its depiction of a recording inhibition seal.

The flaw in the examiner's reasoning is that it does not rely upon a prior art disclosure which discloses covering a functional area of a disk, let alone the presently claimed power calibration area. As explained by appellant, Example 1 of Takahashi utilizes an inhibition seal which presents a logical choice for not recording but does not physically interfere with the functional area of the recording medium. Accordingly, the examiner's conclusion of obviousness is without the requisite factual support. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied 389 U.S. 1057 (1968). In addition, the examiner has failed to articulate the rejection of separately argued claims 4-7, or respond to appellant's arguments for these claims. Such a failure constitutes reversible error.

Appeal No. 2002-1235  
Application No. 08/823,823

while we agree with appellant that the examiner has not established a prima facie case of obviousness for the appealed claims, we do not agree with appellant that "[t]he examiner has not cited any prior art that teaches or suggests covering a functional area of a medium" (page 1 of Reply Brief, second paragraph). Example 2 of Takahashi expressly discloses "a recording inhibition sheet member which is removably attached to at least cover the recording area of the optical disk memory body for blocking the recording light, allowing only the reproduction light to pass through the sheet" (page 4 of translation, third paragraph). As stated at page 5 of the translation, "this invention provides a method that removably adheres a recording inhibition sheet having a filtering function for specific optical frequencies (recording frequency) at least in the area of the recording region to inhibit the data overwriting" (first paragraph). The exemplification of this process can be found at page 10 et seq. of the translation. Accordingly, based on this section of the Takahashi disclosure which has not been relied upon by the examiner nor addressed by appellant, this application is remanded to the examiner to determine the obviousness of covering the power calibration area of a disk in the same manner the recording area of the disk is covered in Takahashi. Since it

Appeal No. 2002-1235  
Application No. 08/823,823

was admittedly known in the art that the power calibration area of the disk is necessarily readable in order to effect recording, it may well have been a matter of obviousness, based upon the admitted prior art and Takahashi, to cover a functional area of the disk other than the recording area, namely, the presently claimed power calibration area. As for appellant's use of an abrasive tool to abrade the power calibration area to render the disk permanently non-recordable, the examiner should determine the obviousness of destroying a feature of the disk that is necessary for recording when recording is not desired. Likewise, the examiner should determine the obviousness of the appealed claims separately argued by appellant.

In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103 are reversed. This application is remanded to the examiner for the reasons set forth above.

Appeal No. 2002-1235  
Application No. 08/823,823

This application, by virtue of its "special" status,  
requires immediate action by the examiner. See the Manual of  
Patent Examining Procedure, § 708.01(D) (8th ed., Aug. 2001).

REVERSED AND REMANDED

*Edward C. Kimlin*  
EDWARD C. KIMLIN  
Administrative Patent Judge

*Charles F. Warren*  
CHARLES F. WARREN  
Administrative Patent Judge

*Thomas A. Waltz*  
THOMAS A. WALTZ  
Administrative Patent Judge

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BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

ECK:clm

Appeal No. 2002-1235  
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-8-

HEWLETT-PACKARD COMPANY  
IP Administration, Mailstop 20BN  
P.O. Box 10301  
Palo Alto, California 94303-0890

**PATENT APPLICATION****ATTORNEY DOCKET NO. 10970451-4****IN THE  
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DISKS**

**COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450**

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**SEP 24 2004**

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Finally, the phase change material in the Power Calibration Area may be intentionally damaged (page 6, lines 13-20), rendering the disk permanently write protected.

Claim 1 specifies an apparatus for write protection of a disk (figures 1 and 3, 102), the disk having a power calibration area (figure 3, 304; page 4, lines 14-19) and a data area (figure 3, circle 302 defines the beginning of the data area; page 4, lines 10-12), the apparatus comprising a ring (figure 4, 406; figure 5, 500) capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

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Claim 7, dependent on claim 6, further specifies that the disk is adapted to receive light from a laser having a particular wavelength (page 5, lines 6-7), the step of shielding further comprising covering the power calibration area with a material that is non-transparent at the particular wavelength (page 5, lines 6-9 and lines 21-23).

Claim 8, dependent on claim 7, further specifies that the material comprises an adhesive label (figure 5, 500; page 5, lines 13-20).

Claim 9, dependent on claim 7, further specifies that the material comprises an ink (page 5, lines 20-21).

Claim 10, dependent on claim 7, further specifies that the material comprises a dye (figure 5, 500; page 5, lines 13-20).

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### **ARGUMENT**

#### **Claims 1-3 and 6-11**

In claims 1-3 and 6-11, the power calibration area, but not the data area, is covered. The cited prior art, individually or in combination, do not teach or suggest covering or shielding the power calibration area, but not the data area.

Applicant stipulates that the power calibration area is known in the prior art (Parker and Starrett). Further, applicant is not contesting the combination of Parker and Starrett with Takhashi for claims 1-3 and 6-11. However, applicant is contesting whether there is any teaching or suggestion to modify the combination to implement the specific limitations of independent claims 1 and 6.

Takahashi discloses covering at least part of the recording area, but does not teach or suggest specifically not covering the data area. The examiner states the general (existence of the power calibration area, and covering at least part of the recording area) and simply concludes the specific limitation of covering just the power calibration area, and

not covering the data area, without reference to any suggestion or motivation in the prior art to modify.

In the office action dated 06/24/2004, regarding modification of the prior art, the examiner merely refers to the office action dated 12/24/2003. In the office action dated 12/24/2003, the examiner states:

“Therefore, it would have been obvious to one of ordinary skill in the art to cover the power calibration area of the disk of the prior art discussed above in the same manner that the recording area of the disk is covered in Takahashi.

Since it was admittedly known in the prior art (discussed above), that the Power Calibration Area (PCA) of the disk is necessary readable in order to effect recording, therefore, it would have been obvious to one of ordinary skill in the art, based upon the admitted prior art and Takahashi, to cover the functional area of the disk other than the recording area, such as “Power Calibration Area”.”

The examiner's statements are an unsupported conclusion, and do not meet the requirements of a *prima facie* case for obviousness. From MPEP 2142, the combined prior art references must teach or suggest all the claim limitations. The prior art references do not teach the specific limitation of covering the power calibration area but not the data area. Accordingly, the references must be modified. In Takahashi, page 5, lower right column, line 5 to line 10, where Takahashi suggests covering at least part of a recording area, it is in the context of a seal member that permits light for reading but prevents light from recording. That is, if the seal does not interfere with reading, then it does not matter whether it covers up part of the data area. Accordingly, there is no motivation within the combination of references to modify the references to require the limitation that the data area is not covered. Applicant respectfully submits that if one covers the power calibration area in the same manner that the recording area of the disk is covered in Takahashi, then there is no motivation to not cover the data area, because in Takahashi reading can still occur if part of the data area is covered.

In response to applicant's argument that teaching of a general arrangement does not teach or suggest a specific arrangement, in the office action dated 06/24/2004, the examiner acknowledged *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Jones*, at page 1942, as discussed in MPEP 2143.01, teaches that disclosure of a

chemical genus does not render obvious any species that happens to fall within it. It is not clear to the applicant whether this cite was an acknowledgement of the validity of the applicant's argument, or was intended to be a rebuttal.

#### Claim 4

Claim 4, dependent on claim 1, specifies a ring that is initially transparent, that is then darkened by exposure to a laser. The examiner has cited no prior art, individually or in combination, teaching or suggesting a transparent ring that is darkened by a laser. Accordingly, no *prima facie* case for obviousness has been established for claim 4.

In the Board's decision in the previous appeal (Appendix 2), at page 6, the Board instructs the examiner to determine the obviousness of each of the appealed claims argued separately by the applicant. The examiner has failed to address the specific limitations of claim 4. In the office action dated 12/24/2003, at page 4, the examiner lumps claim 4 with claims 8-11, citing only seals in Takahashi having dark/bright patterns, and seals of a single color, which are irrelevant to a transparent ring that is darkened by a laser.

#### Claim 5

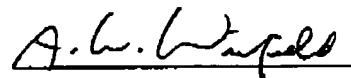
Claim 5 specifies an apparatus adapted to abrade the power calibration area of a disk. The examiner has cited no prior art, individually or in combination, teaching or suggesting an apparatus for abrading a functional area of a recordable medium. Accordingly, no *prima facie* case for obviousness has been established for claim 5.

Regarding claim 5, in the office action dated 12/24/2003, at page 4, the examiner states that Takahashi teaches that by covering or painting the power calibration area, the phase change material or transparent cover layer is partially damaged or destroyed. First, Takahashi does not teach a power calibration area. Second, Takahashi does not teach that covering or painting damages or destroys the phase change material or the transparent cover layer. Third, Takahashi does not teach or suggest abrasion.

**CONCLUSION**

In view of the above, applicant respectfully requests that the examiner's rejection of claims 1-11 be reversed.

Respectfully submitted,



Augustus W. Winfield

Reg. No. 34,046

September 24, 2004  
Fort Collins, CO 80528-9599  
(970) 898-3142

**APPENDIX 1****CLAIMS ON APPEAL**

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:  
a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.
2. The apparatus of claim 1, the disk having a central hole and an indented area formed around the hole, the ring adapted for insertion into the indented area.
3. The apparatus of claim 1, the ring comprising an adhesive label.
4. The apparatus of claim 1, the ring being transparent initially, and then darkened by exposure to a laser.
5. An apparatus for write protection of a disk, the disk having a central hole and a power calibration area, the apparatus comprising:  
a holder adapted to fit into the central hole of the disk; and  
an abrasive tool, rotating around the holder, adapted to abrade the power calibration area when rotated.
6. A method of write protection for a disk, the disk having a power calibration area for a laser and a data area, the method comprising:  
shielding the power calibration area of the disk, but not the data area, from light sufficiently to prevent a disk drive from using the power calibration area to calibrate a laser.

7. The method of claim 6, the disk adapted to receive light from a laser having a particular wavelength, the step of shielding further comprising:  
covering the power calibration area with a material that is non-transparent at the particular wavelength.
8. The method of claim 7, the material comprising an adhesive label.
9. The method of claim 7, the material comprising an ink.
10. The method of claim 7, the material comprising a dye.
11. The method of claim 7, the material comprising a paint.

## **APPENDIX 2**

### **PREVIOUS DECISION BY THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**APPENDIX II**

10970451-4

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

NOV 18 2003

Ex parte LAWRENCE N. TAUGHERHP LEGAL  
IPAAppeal No. 2002-1235  
Application No. 08/823,823

ON BRIEF

Before KIMLIN, WARREN and WALTZ, Administrative Patent Judges.KIMLIN, Administrative Patent Judge.DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11.

Claim 1 is illustrative:

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:

a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Appeal No. 2002-1235  
Application No. 08/823,823

In addition to the admitted prior art, the examiner relies upon the following references as evidence of obviousness:

Takahashi et al. (Takahashi) 04-095287 Mar. 27, 1992  
(Japanese Published Unexamined Patent)

Dana J. Parker et al. (Parker), CD-ROM Professional's CD-Recordable Handbook - The Complete Guide to Practical Desktop CD 92-85 (David R. Guenetta ed., 1996)

Appellant's claimed invention is directed to an apparatus and method of providing write protection of a recordable disk by covering or altering the power calibration area of the disk. According to appellant's specification, before writing or recording information on a disk, the disk drive must calibrate laser power by writing into the power calibration area. If the drive cannot read its calibration pattern in the calibration area on the disk, "it will not erase or write in the data area of the disk" (page 2 of specification, second paragraph). In the present case, appellant covers or abrades the power calibration area to prevent writing data on the recordable area of the disk.

Appealed claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph. Appealed claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Parker and Takahashi.

Appeal No. 2002-1235  
Application No. 08/823,823

Appellant presents separate arguments for claims 1, 4, 5, 6 and 7, whereas claims 2, 3 and 8-11 stand or fall together with the claims upon which they depend.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the examiner's rejections are not well-founded. Accordingly, we will not sustain the examiner's § 112 and § 103 rejections.

Concerning the examiner's rejection of claims 1-4 under § 112, second paragraph, it is the examiner's position "the phrase 'capable of' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention" (page 3 of Answer, last sentence). However, we agree with appellant that the claim language is an appropriate use of functional language which requires that the recited ring be capable of being attached to the disk such that it covers the power calibration area but not the data area. The examiner has not met the initial burden of explaining why, prima facie, one of ordinary skill in the art would not be reasonably apprised of the scope of claims 1-4.

We now turn to the examiner's § 103 rejection of all the appealed claims. The examiner correctly states that it is part

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Application No. 08/823,823

of the admitted prior art that a recordable disk has a power calibration area that must be read by a laser before recording is accomplished. The examiner then concludes that "[t]o cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art" (page 4 of Answer, third paragraph). The examiner further cites Figure 1 of Takahashi for its depiction of a recording inhibition seal.

The flaw in the examiner's reasoning is that it does not rely upon a prior art disclosure which discloses covering a functional area of a disk, let alone the presently claimed power calibration area. As explained by appellant, Example 1 of Takahashi utilizes an inhibition seal which presents a logical choice for not recording but does not physically interfere with the functional area of the recording medium. Accordingly, the examiner's conclusion of obviousness is without the requisite factual support. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied 389 U.S. 1057 (1968). In addition, the examiner has failed to articulate the rejection of separately argued claims 4-7, or respond to appellant's arguments for these claims. Such a failure constitutes reversible error.

Appeal No. 2002-1235  
Application No. 08/823,823

While we agree with appellant that the examiner has not established a prima facie case of obviousness for the appealed claims, we do not agree with appellant that "[t]he examiner has not cited any prior art that teaches or suggests covering a functional area of a medium" (page 1 of Reply Brief, second paragraph). Example 2 of Takahashi expressly discloses "a recording inhibition sheet member which is removably attached to at least cover the recording area of the optical disk memory body for blocking the recording light, allowing only the reproduction light to pass through the sheet" (page 4 of translation, third paragraph). As stated at page 5 of the translation, "this invention provides a method that removably adheres a recording inhibition sheet having a filtering function for specific optical frequencies (recording frequency) at least in the area of the recording region to inhibit the data overwriting" (first paragraph). The exemplification of this process can be found at page 10 et seq. of the translation. Accordingly, based on this section of the Takahashi disclosure which has not been relied upon by the examiner nor addressed by appellant, this application is remanded to the examiner to determine the obviousness of covering the power calibration area of a disk in the same manner the recording area of the disk is covered in Takahashi. Since it

Appeal No. 2002-1235  
Application No. 08/823,823

was admittedly known in the art that the power calibration area of the disk is necessarily readable in order to effect recording, it may well have been a matter of obviousness, based upon the admitted prior art and Takahashi, to cover a functional area of the disk other than the recording area, namely, the presently claimed power calibration area. As for appellant's use of an abrasive tool to abrade the power calibration area to render the disk permanently non-recordable, the examiner should determine the obviousness of destroying a feature of the disk that is necessary for recording when recording is not desired. Likewise, the examiner should determine the obviousness of the appealed claims separately argued by appellant.

In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103 are reversed. This application is remanded to the examiner for the reasons set forth above.

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Application No. 08/823,823

This application, by virtue of its "special" status,  
requires immediate action by the examiner. See the Manual of  
Patent Examining Procedure, § 708.01(D) (8th ed., Aug. 2001).

REVERSED AND REMANDED

*Edward C. Kimlin*  
EDWARD C. KIMLIN  
Administrative Patent Judge

*Charles F. Warren*  
CHARLES F. WARREN  
Administrative Patent Judge

*Thomas A. Waltz*  
THOMAS A. WALTZ  
Administrative Patent Judge

)  
)  
)  
)  
BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

ECK:clm

Appeal No. 2002-1235  
Application No. 08/823,823

Hewlett Packard Co.  
P.O. Box 272400, 3404 E. Harmony Road  
Intellectual Property Administration  
Fort Collins, CO 80527-2400

HEWLETT-PACKARD COMPANY  
IP Administration, Mailstop 20BN  
P.O. Box 10301  
Palo Alto, California 94303-0890

**PATENT APPLICATION****ATTORNEY DOCKET NO. 10970451-4****IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE****Inventor(s): Lawrence N. Taucher****Serial No.: 08/823,823****Examiner: Neyzari, Ali****Filing Date: 03/25/97****Group Art Unit: 2655****Title: WRITE PROTECT FOR REWRITABLE COMPACT DISKS AND DIGITAL VIDEO  
DISKS**

**COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450**

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**BRIEF ON APPEAL****SEP 24 2004****INTRODUCTION**

Pursuant to the provisions of 37 CFR § 1.191 *et seq.*, applicants hereby appeal to the Board of Patent Appeals and Interferences (the "Board") from the examiner's final rejection dated 01/02/01. A notice of appeal was timely filed on 09/24/2004 concurrently with this brief on appeal, in accordance with 37 CFR § 1.8. This brief on appeal is being filed in triplicate (37 CFR § 1.192(a)) and is accompanied by the requisite fee (37 CFR 1.192(a) and 1.17(c)).

**REAL PARTY IN INTEREST**

The entire interest in the present application has been assigned to Hewlett-Packard Company, as recorded at reel 8690, frame 0272.

**RELATED APPEALS AND INTERFERENCES**

An earlier appeal brief was filed on 06/04/2001 (Appeal No. 2002-1235). The Board of Patent Appeals and Interferences, in a decision received 11/18/2003, reversed and remanded in light of a full translation of Japanese Published Unexamined Patent 04-095287 (Takahashi). A copy of the previous decision is attached as Appendix II.

## STATUS OF CLAIMS

Claims 1-11 are pending in the application.

Claims 1-11 have been finally rejected.

Claims 1-11 are on appeal.

## STATUS OF AMENDMENTS

There are no after-final amendments.

## SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates generally to digital mass memory media, and more specifically to rewritable optical disks, and still more specifically to devices and methods used to prevent writing to a rewritable optical disk. One layer of the media is a phase change material (figure 2, 200; page 3, line 25) having a transparency that can be reversibly changed by heating, and then cooling at a controlled rate (page 3, line 26, to page 4, line 3). A laser (figure 1, 104; page 3, line 22) is used to heat, and then cool small areas at a controlled rate. Laser power must be calibrated for each disk medium (page 4, lines 14 - 18). Before writing or erasing, a standard drive must successfully calibrate laser power by writing into a Power Calibration Area (figure 3, 304) on the medium. If the drive cannot read its calibration patterns in the Power Calibration Area, it will not erase or write in the data area of the disk. In some example embodiments of the invention, the Power Calibration Area is temporarily obscured, preventing a successful calibration. For example, the Power Calibration Area may be covered by removable opaque plastic rings (figure 4, 406; page 4, line 24 through page 5, line 13) or adhesive labels (figure 5, 500; page 5, lines 13-23). In other example embodiments, the Power Calibration Area is permanently obscured or covered for permanent write protection. For example, the surface of the disk in the Power Calibration Area may be scratched or abraded (figure 6; page 6, lines 5-12).

Finally, the phase change material in the Power Calibration Area may be intentionally damaged (page 6, lines 13-20), rendering the disk permanently write protected.

Claim 1 specifies an apparatus for write protection of a disk (figures 1 and 3, 102), the disk having a power calibration area (figure 3, 304; page 4, lines 14-19) and a data area (figure 3, circle 302 defines the beginning of the data area; page 4, lines 10-12), the apparatus comprising a ring (figure 4, 406; figure 5, 500) capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Claim 2, dependent on claim 1, further specifies the disk having a central hole (figures 3 and 4, 300) and an indented area (figure 4, 402; page 4, line 24, through page 5, line 6) formed around the hole, the ring adapted for insertion into the indented area.

Claim 3, dependent on claim 1, further specifies that the ring comprises an adhesive label (figure 5, 500; page 5, lines 13-20).

Claim 4, dependent on claim 1, further specifies that the ring is transparent initially, and then darkened by exposure to a laser (page 6, lines 21-28).

Claim 5 (independent) specifies an apparatus for write protection of a disk (figures 1 and 3, 102), the disk having a central hole (figures 3 and 6, 300) and a power calibration area (figure 3, 304; page 4, lines 14-19), the apparatus comprising a holder (figure 6, 600; page 6, lines 5-12) adapted to fit into the central hole of the disk and an abrasive tool (figure 6, 606) rotating around the holder, adapted to abrade the power calibration area when rotated.

Claim 6 (independent) specifies a method of write protection for a disk (figures 1 and 3, 102), the disk having a power calibration area (figure 3, 304; page 4, lines 14-19) for a laser, and a data area (figure 3, circle 302 defines the beginning of the data area; page 4, lines 10-12), the method comprising shielding the power calibration area, but not the data area, of the disk from light sufficiently to prevent a disk drive from using the power calibration area to calibrate a laser (page 4, line 19; page 4, line 28 through page 5, line 2; page 5, lines 17-18 and lines 20-21; page 6, lines 8-9 and lines 24-25).

Claim 7, dependent on claim 6, further specifies that the disk is adapted to receive light from a laser having a particular wavelength (page 5, lines 6-7), the step of shielding further comprising covering the power calibration area with a material that is non-transparent at the particular wavelength (page 5, lines 6-9 and lines 21-23).

Claim 8, dependent on claim 7, further specifies that the material comprises an adhesive label (figure 5, 500; page 5, lines 13-20).

Claim 9, dependent on claim 7, further specifies that the material comprises an ink (page 5, lines 20-21).

Claim 10, dependent on claim 7, further specifies that the material comprises a dye (figure 5, 500; page 5, lines 13-20).

Claim 11, dependent on claim 7, further specifies that the material comprises a paint (figure 5, 500; page 5, lines 13-20).

#### GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-11 are unpatentable under 35 U.S.C. § 103(a) in light of prior art disclosed in the specification, in view of "CD Recordable Handbook" by Parker and Starrett, and further in view of Japanese Patent Number 404095287 (Takahashi).

#### ARGUMENT

##### Claims 1-3 and 6-11

In claims 1-3 and 6-11, the power calibration area, but not the data area, is covered. The cited prior art, individually or in combination, do not teach or suggest covering or shielding the power calibration area, but not the data area.

Applicant stipulates that the power calibration area is known in the prior art (Parker and Starrett). Further, applicant is not contesting the combination of Parker and Starrett with Takhashi for claims 1-3 and 6-11. However, applicant is contesting whether there is any teaching or suggestion to modify the combination to implement the specific limitations of independent claims 1 and 6.

Takahashi discloses covering at least part of the recording area, but does not teach or suggest specifically not covering the data area. The examiner states the general (existence of the power calibration area, and covering at least part of the recording area) and simply concludes the specific limitation of covering just the power calibration area, and

not covering the data area, without reference to any suggestion or motivation in the prior art to modify.

In the office action dated 06/24/2004, regarding modification of the prior art, the examiner merely refers to the office action dated 12/24/2003. In the office action dated 12/24/2003, the examiner states:

“Therefore, it would have been obvious to one of ordinary skill in the art to cover the power calibration area of the disk of the prior art discussed above in the same manner that the recording area of the disk is covered in Takahashi.

Since it was admittedly known in the prior art (discussed above), that the Power Calibration Area (PCA) of the disk is necessary readable in order to effect recording, therefore, it would have been obvious to one of ordinary skill in the art, based upon the admitted prior art and Takahashi, to cover the functional area of the disk other than the recording area, such as “Power Calibration Area”.”

The examiner's statements are an unsupported conclusion, and do not meet the requirements of a *prima facie* case for obviousness. From MPEP 2142, the combined prior art references must teach or suggest all the claim limitations. The prior art references do not teach the specific limitation of covering the power calibration area but not the data area. Accordingly, the references must be modified. In Takahashi, page 5, lower right column, line 5 to line 10, where Takahashi suggests covering at least part of a recording area, it is in the context of a seal member that permits light for reading but prevents light from recording. That is, if the seal does not interfere with reading, then it does not matter whether it covers up part of the data area. Accordingly, there is no motivation within the combination of references to modify the references to require the limitation that the data area is not covered. Applicant respectfully submits that if one covers the power calibration area in the same manner that the recording area of the disk is covered in Takahashi, then there is no motivation to not cover the data area, because in Takahashi reading can still occur if part of the data area is covered.

In response to applicant's argument that teaching of a general arrangement does not teach or suggest a specific arrangement, in the office action dated 06/24/2004, the examiner acknowledged *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In re Jones*, at page 1942, as discussed in MPEP 2143.01, teaches that disclosure of a

chemical genus does not render obvious any species that happens to fall within it. It is not clear to the applicant whether this cite was an acknowledgement of the validity of the applicant's argument, or was intended to be a rebuttal.

#### Claim 4

Claim 4, dependent on claim 1, specifies a ring that is initially transparent, that is then darkened by exposure to a laser. The examiner has cited no prior art, individually or in combination, teaching or suggesting a transparent ring that is darkened by a laser. Accordingly, no *prima facie* case for obviousness has been established for claim 4.

In the Board's decision in the previous appeal (Appendix 2), at page 6, the Board instructs the examiner to determine the obviousness of each of the appealed claims argued separately by the applicant. The examiner has failed to address the specific limitations of claim 4. In the office action dated 12/24/2003, at page 4, the examiner lumps claim 4 with claims 8-11, citing only seals in Takahashi having dark/bright patterns, and seals of a single color, which are irrelevant to a transparent ring that is darkened by a laser.

#### Claim 5

Claim 5 specifies an apparatus adapted to abrade the power calibration area of a disk. The examiner has cited no prior art, individually or in combination, teaching or suggesting an apparatus for abrading a functional area of a recordable medium. Accordingly, no *prima facie* case for obviousness has been established for claim 5.

Regarding claim 5, in the office action dated 12/24/2003, at page 4, the examiner states that Takahashi teaches that by covering or painting the power calibration area, the phase change material or transparent cover layer is partially damaged or destroyed. First, Takahashi does not teach a power calibration area. Second, Takahashi does not teach that covering or painting damages or destroys the phase change material or the transparent cover layer. Third, Takahashi does not teach or suggest abrasion.

**CONCLUSION**

In view of the above, applicant respectfully requests that the examiner's rejection of claims 1-11 be reversed.

Respectfully submitted,



Augustus W. Winfield

Reg. No. 34,046

September 24, 2004  
Fort Collins, CO 80528-9599  
(970) 898-3142

**APPENDIX 1****CLAIMS ON APPEAL**

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:
  - a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.
2. The apparatus of claim 1, the disk having a central hole and an indented area formed around the hole, the ring adapted for insertion into the indented area.
3. The apparatus of claim 1, the ring comprising an adhesive label.
4. The apparatus of claim 1, the ring being transparent initially, and then darkened by exposure to a laser.
5. An apparatus for write protection of a disk, the disk having a central hole and a power calibration area, the apparatus comprising:
  - a holder adapted to fit into the central hole of the disk; and
  - an abrasive tool, rotating around the holder, adapted to abrade the power calibration area when rotated.
6. A method of write protection for a disk, the disk having a power calibration area for a laser and a data area, the method comprising:
  - shielding the power calibration area of the disk, but not the data area, from light sufficiently to prevent a disk drive from using the power calibration area to calibrate a laser.

7. The method of claim 6, the disk adapted to receive light from a laser having a particular wavelength, the step of shielding further comprising:  
covering the power calibration area with a material that is non-transparent at the particular wavelength.
8. The method of claim 7, the material comprising an adhesive label.
9. The method of claim 7, the material comprising an ink.
10. The method of claim 7, the material comprising a dye.
11. The method of claim 7, the material comprising a paint.

**APPENDIX 2**

**PREVIOUS DECISION BY THE BOARD OF PATENT APPEALS AND  
INTERFERENCES**

**APPENDIX II**

10970451-4

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

NOV 18 2003

HP LEGAL  
IPAEx parte LAWRENCE N. TAUGHERAppeal No. 2002-1235  
Application No. 08/823,823

ON BRIEF

Before KIMLIN, WARREN and WALTZ, Administrative Patent Judges.KIMLIN, Administrative Patent Judge.**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 1-11.

Claim 1 is illustrative:

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:

a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Appeal No. 2002-1235  
Application No. 08/823,823

In addition to the admitted prior art, the examiner relies upon the following references as evidence of obviousness:

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(Japanese Published Unexamined Patent)

Dana J. Parker et al. (Parker), CD-ROM Professional's CD-Recordable Handbook - The Complete Guide to Practical Desktop CD 82-85 (David R. Guenetta ed., 1996)

Appellant's claimed invention is directed to an apparatus and method of providing write protection of a recordable disk by covering or altering the power calibration area of the disk. According to appellant's specification, before writing or recording information on a disk, the disk drive must calibrate laser power by writing into the power calibration area. If the drive cannot read its calibration pattern in the calibration area on the disk, "it will not erase or write in the data area of the disk" (page 2 of specification, second paragraph). In the present case, appellant covers or abrades the power calibration area to prevent writing data on the recordable area of the disk.

Appealed claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph. Appealed claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Parker and Takahashi.

Appeal No. 2002-1235  
Application No. 08/623,823

Appellant presents separate arguments for claims 1, 4, 5, 6 and 7, whereas claims 2, 3 and 8-11 stand or fall together with the claims upon which they depend.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the examiner's rejections are not well-founded. Accordingly, we will not sustain the examiner's § 112 and § 103 rejections.

Concerning the examiner's rejection of claims 1-4 under § 112, second paragraph, it is the examiner's position "the phrase 'capable of' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention" (page 3 of Answer, last sentence). However, we agree with appellant that the claim language is an appropriate use of functional language which requires that the recited ring be capable of being attached to the disk such that it covers the power calibration area but not the data area. The examiner has not met the initial burden of explaining why, prima facie, one of ordinary skill in the art would not be reasonably apprised of the scope of claims 1-4.

We now turn to the examiner's § 103 rejection of all the appealed claims. The examiner correctly states that it is part

Appeal No. 2002-1235  
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of the admitted prior art that a recordable disk has a power calibration area that must be read by a laser before recording is accomplished. The examiner then concludes that "[t]o cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art" (page 4 of Answer, third paragraph). The examiner further cites Figure 1 of Takahashi for its depiction of a recording inhibition seal.

The flaw in the examiner's reasoning is that it does not rely upon a prior art disclosure which discloses covering a functional area of a disk, let alone the presently claimed power calibration area. As explained by appellant, Example 1 of Takahashi utilizes an inhibition seal which presents a logical choice for not recording but does not physically interfere with the functional area of the recording medium. Accordingly, the examiner's conclusion of obviousness is without the requisite factual support. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied 389 U.S. 1057 (1968). In addition, the examiner has failed to articulate the rejection of separately argued claims 4-7, or respond to appellant's arguments for these claims. Such a failure constitutes reversible error.

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While we agree with appellant that the examiner has not established a prima facie case of obviousness for the appealed claims, we do not agree with appellant that "[t]he examiner has not cited any prior art that teaches or suggests covering a functional area of a medium" (page 1 of Reply Brief, second paragraph). Example 2 of Takahashi expressly discloses "a recording inhibition sheet member which is removably attached to at least cover the recording area of the optical disk memory body for blocking the recording light, allowing only the reproduction light to pass through the sheet" (page 4 of translation, third paragraph). As stated at page 5 of the translation, "this invention provides a method that removably adheres a recording inhibition sheet having a filtering function for specific optical frequencies (recording frequency) at least in the area of the recording region to inhibit the data overwriting" (first paragraph). The exemplification of this process can be found at page 10 et seq. of the translation. Accordingly, based on this section of the Takahashi disclosure which has not been relied upon by the examiner nor addressed by appellant, this application is remanded to the examiner to determine the obviousness of covering the power calibration area of a disk in the same manner the recording area of the disk is covered in Takahashi. Since it

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was admittedly known in the art that the power calibration area of the disk is necessarily readable in order to effect recording, it may well have been a matter of obviousness, based upon the admitted prior art and Takahashi, to cover a functional area of the disk other than the recording area, namely, the presently claimed power calibration area. As for appellant's use of an abrasive tool to abrade the power calibration area to render the disk permanently non-recordable, the examiner should determine the obviousness of destroying a feature of the disk that is necessary for recording when recording is not desired. Likewise, the examiner should determine the obviousness of the appealed claims separately argued by appellant.

In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103 are reversed. This application is remanded to the examiner for the reasons set forth above.

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This application, by virtue of its "special" status,  
requires immediate action by the examiner. See the Manual of  
Patent Examining Procedure, § 708.01(D) (8th ed., Aug. 2001).

REVERSED AND REMANDED

*Edward C. Kimlin*  
EDWARD C. KIMLIN )  
Administrative Patent Judge )  
)

*Charles F. Warren*  
CHARLES F. WARREN )  
Administrative Patent Judge )  
)

*Thomas A. Waltz*  
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